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EXAMINER
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CHONG, YONG SOO

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1627

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 3, 5-6, 8-9, 17-20, 22-23, drawn to a pharmaceutical composition comprising the compound of formula I and a pharmaceutically acceptable carrier, where A is a 5-membered heteroaryl or heterocyclyl ring.

Group II, claim(s) 1, 3, 5-6, 8-9, 17-20, 22-23, drawn to a pharmaceutical composition comprising the compound of formula I and a pharmaceutically acceptable carrier, where A is a 6-membered heteroaryl or heterocyclyl ring.

Group III, claim(s) 29 is drawn to a method of treating inflammation comprising providing a patient with a therapeutically effective serum concentration of a compound of formula I, where A is a 5-membered heteroaryl or heterocyclyl ring.

Group IV, claim(s) 29 is drawn to a method of treating inflammation comprising providing a patient with a therapeutically effective serum concentration of a compound of formula I, where A is a 6-membered heteroaryl or heterocyclyl ring.

Group V, claim(s) 31 is drawn to a method of treating pain comprising providing a patient with a therapeutically effective serum concentration of a compound of formula I, where A is a 5-membered heteroaryl or heterocyclyl ring.

Group VI, claim(s) 31 is drawn to a method of treating pain comprising providing a patient with a therapeutically effective serum concentration of a compound of formula I, where A is a 6-membered heteroaryl or heterocyclyl ring.

Group VII, claim(s) 37 is drawn to a method of treating anxiety comprising providing a patient with a therapeutically effective serum concentration of a compound of formula I, where A is a 5-membered heteroaryl or heterocyclyl ring.

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Group VIII, claim(s) 37 is drawn to a method of treating anxiety comprising providing a patient with a therapeutically effective serum concentration of a compound of formula I, where A is a 6-membered heteroaryl or heterocyclyl ring.

Group IX, claim(s) 41 is drawn to a method of treating a sleep disorder comprising providing a patient with a therapeutically effective serum concentration of a compound of formula I, where A is a 5-membered heteroaryl or heterocyclyl ring.

Group X, claim(s) 41 is drawn to a method of treating a sleep disorder comprising providing a patient with a therapeutically effective serum concentration of a compound of formula I, where A is a 6-membered heteroaryl or heterocyclyl ring.

The inventions listed as Groups I-X do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Groups I-X lack unity because the shared common technical feature is not a contribution over the prior art. Since it is well known in the art, it cannot be considered a special technical feature. In the instant case, the shared common technical feature is a compound of formula I in claim 1.

Unity of invention links the various inventions together by sharing a common special technical feature in each invention. However, when the special technical feature is not a contribution over the prior art, the various inventions may be restricted from each other. In the instant case, unity of invention does not exist because the shared common technical feature is disclosed in Thomsen et al. (1989CA: 153968, 1989, of record); US Patent 6,294,505 B1; US Patent 6,262,098 B1; and WO 00/51685.

Therefore, restriction between the composition and method claims is proper. See MPEP 1850 and 37 CFR 1.475.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

### ***Species Election***

This application contains claims directed to more than one species of the generic invention.

The species are as follows:

1) a single disclosed compound of formula I in claim 1.

If applicant elects Group I-X, applicant is further required to elect a single disclosed compound of formula I in claim 1 from subsection 1. Currently, claim(s) 1, 3, 5-6, 8-9, 17-20, 22-23 are generic to a compound of formula I in claim 1.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical feature for the same reasons as stated above

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will then be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR

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1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a)

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

A telephone call to the attorney is not required where: 1) the restriction requirement is complex; 2) the application is being prosecuted pro se; or 3) the

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examiner knows from past experience that a telephone election will not be made (MPEP § 812.01). Therefore, since this restriction requirement is considered complex, a call to the attorney for telephone election was not made.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong S. Chong whose telephone number is (571)-272-8513. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SREENI PADMANABHAN can be reached on (571)-272-0629. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/YONG S. CHONG/  
Primary Examiner, Art Unit 1617

YSC